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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/918,505

08/01/2001

Vincenzo Sestito

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04/15/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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EXAMINER

MURPHY, RHONDA L

ART UNIT

PAPER NUMBER

2667

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,505

Applicant(s)

SESTITO ET AL. 

Examiner

Rhonda Murphy

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3,8,10 and 16 is/are rejected.
- 7) ☒ Claim(s) 2,4-7,9 and 11-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/1/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/918504. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application merely broadens the scope of claim 1 of the co-pending application 09/918504 by eliminating the elements and their functions of the claims. The following limitation has been excluded from the instant application:

a Time Slot Interchange path wherein different high priority time slots are occupied in different path spans; providing each time slot with an index.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969);

omission of a reference element whose function is not needed would be obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 8 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/918504. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 8 and 16 of the instant application merely broadens the scope of claim 12 of the co-pending application 09/918504 by eliminating the elements and their functions of the claims. The following limitation has been excluded from the instant application:

a path in a time slot interchange where different high priority time slots are occupied in different path spans.

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd.App.1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 8 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Usuba et al. (US 6,614,754).

Regarding claim 1, Usuba teaches a method of re-routing a path in a Bi-directional Line Switched Ring (BLSR) network in the event of a span failure (col. 1, lines 33-37). A BLSR network in SONET is equivalent to Multiplex Section Shared Protection Ring (MS-SPRing) in SDH. The fiber spans between each node consists of working channels and protection channels. Usuba's method comprises the step of a Time Slot Interchange mechanism where in the event of a failure, a path is maintained by using a protection transmission line with the same time slot number as that of a working transmission line between the adjacent nodes (col. 6, lines 1-5).

Regarding claims 8 and 16, Usuba teaches a BLSR network comprising fiber spans with working channels and protection channels, nodes comprising means for performing ring switch actions, span switching or pass through, upon receipt of corresponding signaling (col. 3, lines 32-37); means for issuing and sending signals upon receipt of the corresponding signaling (col. 3, lines 29-37); a time slot interchange (TSI) path including

means for, in the event of a failure, maintaining a path by using a protection transmission line with the same time slot number as that of a working transmission line between the adjacent nodes (col. 6, lines 1-5).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usuba et al., in view of Ellinas et al. (US 6,760,302).

Regarding claims 3 and 10, Usuba teaches a method of re-routing paths in a BLSR network upon span failures. Usuba does not explicitly teach maintaining the re-routing action of the first span, when a second span fails.

However, Ellinas teaches a lockout protection command that prevents further switching of the protection switches involved in restoring the first failure, so the protection cycle will not be interrupted in an attempt to repair a second failure. Thus, the re-routing action of the first span is maintained.

In view of this, it would have been obvious to one having ordinary skill in the art to include a process of maintaining the re-routing action of the first span, for the purpose of sustaining the protection route for the first span, in the event a second span is affected by failure.

Allowable Subject Matter

5. Claims 2, 4-7, 9, 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*Chaudhuri (US 5,745,476) discloses errorless switching techniques in ring networks.

*Lu (US 5,815,490) discloses SDH ring high order path management.

*Finn et al. (US 6,728,205) discloses a method and apparatus for automatic protection switching.

*Badr (US 6,775,477) discloses an optical communication network and protection methods.

*Watkins et al. (US 6,798,747) discloses a system and method for time slot assignment in a fiber optic network simulation plan.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rhonda Murphy whose telephone number is (571) 272-3185. The examiner can normally be reached on Monday - Friday 8:00 - 4:30pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rhonda Murphy
Examiner
Art Unit 2667

rlm


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 4/8/05